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BOARD OF PATENT APPEALS AND INTERFERENCES

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) BEFORE THE BOARD OF PATENT
Peter FIELD et al.) APPEALS AND INTERFERENCES
Serial No. 08/800,742) Appeal No.: 2000-1739
Filed: February 14, 1997) Examiner: Darnell M. Boucher
For: ELECTROMECHANICAL) Group Art Unit: 3627
CYLINDER LOCK) October 29, 2001

REQUEST FOR REHEARING UNDER 37 CFR § 1.197(b)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a request under 37 CFR § 1.197(b) for reconsideration of the Board's decision dated August 29, 2001.

The Board concluded that it would have been obvious to one of ordinary skill in the art to locate the Nitinol actuator wire and associated operating components of the Aston reference within the plug in light of "the advantage of this arrangement as taught in Gokcebay." In particular, the Board found that such a modification would have been made "for the purpose of creating a lock that can be easily retrofitted into existing locks."

Decision at pp.8-9.

The Board's conclusion appears to be based on the statement of Gokcebay that according to an object of his invention, a system is provided which is easily retrofitted into lock systems and which avoids the need for electronics, solenoids or other hardware which would take up space within the lock casing adjacent to the lock. It is respectfully submitted that the Board has overlooked the fact that the Aston reference as disclosed already provides such a system.

The Board would agree that if the Aston reference already provided a system which is easily retrofitted into lock systems and which avoids the need for electronics, solenoids or other hardware which would take up space within the lock casing adjacent to the lock, then there would exist no reason or purpose to further modify Aston to achieve the stated objectives of the Gokcebay disclosure.

In fact, Aston discloses that according to his invention, "[i]t is thus possible to provide an electronic cylinder type lock which can be used as a direct replacement for a conventional mechanical cylinder-type lock," Col. 1, lines 44-46, "without either cutting an enlarged rebate in the door ... or adding a special-purpose battery holder/bezel to the lock." Col. 1, lines 37-41."

According to Gokcebay, a lock that accomplishes his stated objective is met by providing a lock that "has an electronic

feature which occupies no more space than the mechanical lock itself. Nothing is required outside the lock cylinder ..." Col. 3, lines 1-3. Such a lock is already disclosed in Aston Figs. 2 and 4. As shown, all of the electronics and hardware are provided in the body of the lock cylinder 10, such that "nothing is required outside the lock cylinder."

It is undisputed that the specific embodiment disclosed by Gokcebay contains all electronics and hardware in the cylinder plug; however, no advantage of such a configuration over the configuration already provided by Figs. 2 and 4 of Aston is described or suggested by Gokcebay (or any of the other prior art of record, or in the Examiner's Answer). Because the Aston reference already provides a lock that achieves all of the stated objectives of the Gokcebay reference, there cannot be any reason, suggestion or motivation for one of ordinary skill in art to have made the proposed modification under 35 U.S.C. § 103. Such suggestion cannot come from the applicant's invention itself. In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992).

The mere finding that it is known that all electronics and hardware can be contained in the cylinder plug, as disclosed by Gokcebay, is insufficient to support the conclusion that the proposed modification of Aston would have been obvious to one of ordinary skill in the art. The mere fact that a prior art device could be modified so as to produce the claimed invention is not a

basis for an obviousness rejection. The prior art must have suggested the desirability of the modification. In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992); In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990); In re Laskowski, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

CONCLUSION

In view of the foregoing, the Honorable Board is respectfully requested to reconsider the decision of August 29, 2001, and to reverse all grounds of rejection.

Respectfully submitted,

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